

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-29 are pending in the application, with claims 1, 6, 7, 9-23, and 26-29 being the independent claims. No claims are sought to be canceled. Claims 1-3 and 5-13 are sought to be amended. New claims 23-29 are sought to be added. Claims 14-22 are withdrawn, pursuant to the Reply to Restriction Requirement provided below. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Reply to Restriction Requirement

The Examiner has asserted that a restriction is required under 35 U.S.C. § 121. Specifically, the Examiner asserts that claims 1-22 are directed to three distinct inventions. They are as follows:

Group I, claims 1-13, the claims “directed to an e-mail system comprising the step of: recognizing whether a complete electronic mail message created by an unauthorized process.” *Office Action at p. 3.*

Group II, claims 14, 21-22, the claims “drawn to an e-mail system and a method comprising the step of determining whether an electronic mail message having at least a

minimum of parts needed to be a valid electronic mail message and by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message is to be sent.” *Office Action at p. 3 (with presumed error corrected by including claim 21 in this Group).*

Group III, claims 15-20, the claims “drawn to an e-mail system and a method comprising the step of: recognizing whether a complete electronic mail message by one of a virus, a trojan horse and an agent other than an owner of a mail client source of the message and having a valid recipient address is to be sent, after a send function has been initiated, from a sending side to a receiving side.” *Office Action at p. 3.*

Applicants provisionally elect to prosecute the claims associated with Group I, claims 1-13 and new claims 23-29. Claims 14-22 (associated with Groups II and III) are therefore provisionally withdrawn based on the above election.

This election is made **with traverse**.

A restriction is proper if the claims of an application are either independent or distinct, and the search and examination of the claims cannot be made without a serious burden. *M.P.E.P. § 803.*

The Claims Are Not Distinct

Applicants respectfully traverse the assertion that these Claim Groups are distinct. The Examiner asserts that the embodiments represented by Claim Groups I, II, and III are distinct. *Office Action at pp. 4-6.* Examiner asserts that the embodiments represented by these three Claim Groups are subcombinations that are usable together in a single combination, **do not overlap in scope**, and are separately usable. *Id. (emphasis added).* However, the embodiments represented by the three Claim Groups are not mutually

exclusive, and therefore **do overlap in scope**. Specifically, the Group II claims are directed to “determining whether an electronic mail message having minimum of parts needed to be a valid electronic mail message and by a virus.” Such Group II scope is not mutually exclusive from “recognizing a complete electronic mail message by a virus” (the feature defining Groups I and III), since a “complete electronic mail message” can overlap with an “electronic mail message having minimum of parts.” Accordingly, since these Claim Groups do overlap in scope, Applicants respectfully request that this restriction should be withdrawn on this basis.

Finally, even assuming, *arguendo*, that the three Claim Groups are distinct, Applicants respectfully submit that Claim Groups I, II and III should be examined together, since they are directed to similar, overlapping subject matter. “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” *M.P.E.P.* § 803. “The Examiner must show by appropriate explanation one of the following: (A) Separate classification ... (B) [a] separate status in the art when they are classifiable together [or] ... (C) [a] different field of search.” *M.P.E.P.* § 808.02. The Examiner concedes that the three Claim Groups are classified in the same class, namely: class 709, subclass 206. *See Office Action at p. 3*. Moreover, the Examiner has neither shown a basis for a separate status in the art, nor a different field of search. Indeed, Claim Groups I, II and III have similar features recited, which should encompass a similar search. For example, the three Claim Groups deal with a process or apparatus that deals with suspending e-mail transmissions to enable a user to avoid inadvertent e-mail transmissions or to terminate unauthorized e-mails generated by viruses, etc. As noted in the *M.P.E.P.*, where “the classification is the same and

the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.” See *M.P.E.P.* § 808.02. Accordingly, reconsideration and withdrawal of the Examiner’s restriction on this basis is thereby respectfully requested.

Objection to / Rejection of New Matter

The Examiner has objected under 35 U.S.C. § 132(a) to the alleged introduction of new matter during an amendment. Specifically, the Examiner asserts the following:

- (a) The use of the phrase “created by an unauthorized process” is new matter, as it is unsupported by the specification. *Office Action at p. 2.*
- (b) The use of the phrase “the unauthorized process” is new matter, as it is unsupported by the specification. *Office Action at p. 2.*
- (c) The use of the phrase “one of a virus, a Trojan horse and an agent other than an owner of a mail client source of the message” is new matter, as it is unsupported by the specification. *Office Action at p. 2.*

As an initial matter, Applicants note that the alleged new matter cited by the Examiner appears in the claim amendments. As described in the *M.P.E.P.*, alleged new matter introduced by way of claim amendments should be rejected under 35 U.S.C. § 112 (rather than by an objection under 35 U.S.C. § 132, which is used for new matter introduced into the specification). See *M.P.E.P.* §§ 2163.01, 2163.06(I). Applicants further note the prior decision of Board of Patent Appeals and Interferences (“BPAI”) in the prosecution of this matter, which reinforces this distinction. See *BPAI decision in Appeal 2007-0288 dated*

March 27, 2007 at pp. 5-10. Accordingly, for the purposes of this Office Action reply, Applicants assume that the rejection is made under 35 U.S.C. § 112.

Applicants note that an amended claim must be supported in the specification through "express, implicit or inherent" disclosure. *M.P.E.P. § 2163(I)(B)*. Specifically, there is no *in haec verba* aspect to this support requirement. *Id.* The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. *M.P.E.P. § 2163.02*. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *Id.*

In particular, Applicants specifically traverse the Examiner's assertion that "the use of the words 'compose' and 'send' does not establish that computer viruses are processes." *Office Action at p. 9*. The words "compose" and "send" are verbs which articulate two steps in a process. The specification specifically notes that "computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail." *See Specification, Background Section*. Examiner further asserts that "process is the broader term and it is not automatically encompass 'compose' and 'send'". *Office Action at p. 9*. However, claims are to be "given their broadest reasonable interpretation **consistent with the specification**". (*emphasis added*) *M.P.E.P. § 2111 (quoting Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005))*. Therefore, Applicants respectfully note that any claim interpretation broader than the specification, as read by one of ordinary skill in the art, is not consistent with the requirements set forth in the M.P.E.P. The broadest reasonable interpretation of the claim term "process" is consistent with the embodiments of the specification, which discloses an example of a process in the form of a virus.

Finally, Applicants contend that the previous claim amendments fully satisfy the support requirements, and that appropriate references to the specification support for these claim amendments were provided in the previous Office Action response. However, solely to advance prosecution, Applicants have amended the claims. Nevertheless, Applicants reserve the right to prosecute the now unclaimed subject matter in subsequent continuation applications.

(a) Alleged New Matter – “created by an unauthorized process”

The phrase “created by an unauthorized process” has been changed to “composed by a virus.” Claims 1, 6, 7, and 9-13 have been amended accordingly. Support for the phrase “composed by a virus” may be found in the specification, which states “Today computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.” *Spec. at para. [0010]*. Withdrawal of the Examiner’s objection/rejection is respectfully requested.

(b) Alleged New Matter – “the unauthorized process”

The phrase “the unauthorized process” has been changed to “an unauthorized agent.” Claims 2, 3, and 5 have been amended accordingly. Support for the phrase “an unauthorized agent” may be found in the original claims in the parent application (U.S. Appl. No. 09/337,035), from which this application claims priority. Specifically, original claims 6, 13, 14, and 22 refer to “an unauthorized agent.” *See Appl. No. 09/337,035 at original claims 6, 13, 14, and 22*. Withdrawal of the Examiner’s objection/rejection is respectfully requested.

(c) Alleged New Matter – “one of a virus, a Trojan horse and an agent other than an owner of a mail client source of the message”

The phrase “one of a virus, a Trojan horse and an agent other than an owner of a mail client source of the message” has been changed to a “virus.” Claims 3 and 5 have been amended accordingly. Support for the phrase “composed by a virus” may be found in the specification, which states “Today computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.” *Spec. at para. [0010]*. Withdrawal of the Examiner’s objection/rejection is respectfully requested.

New Claims

Claims 23-29 are sought to be added. Support for the claims may be found implicitly and inherently in the specification, which states “Today computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.” *Spec. at para. [0010]*. Such claims also fall within the scope of Claim Group I, and are therefore elected for further prosecution.


Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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